## REMARKS

This response is directed to the Examiner's Office Action of July 14, 2003, which the Examiner had referenced to Applicant's Amendment of April 21, 2003 (which was a Request for Continued Examination, RCE).

Additionally, this response is directed to Examiner's Office Action of August 11, 2003, which referred to Applicant's Amendment reply of July 15, 2003, as not being fully responsive to the prior Office Action and a period of 1 month or 30 days has been granted to provide for a supplementary response.

As will be noted, in the attached and amended claims, the Applicant has now removed any reference to the following phrases --

In claim 1, Applicant has changed certain phrases as follows:

claim 1(b): ~~second software means for providing~~

claim 1(c): ~~third software~~

claim 1(d): ~~fourth software~~

In claim 4, note these deletions:

claim 4(b): ~~software simulated~~

~~software emulated~~

~~software simulated~~

claim 4(b2): ~~software simulated~~

claim 4(c): ~~software simulated~~

In claim 8, note these deletions:

claim 8(b): ~~software emulated~~

~~a temporary~~

~~implemented software~~

claim 8(f): ~~temporary~~

~~implemented software~~

In claim 12, note these deletions:

claim 12(a): ~~separate software~~

~~emulated temporary~~

claim 12(c) ~~temporary~~

claim 12(e) ~~temporary~~

~~software implemented~~

With the elimination of these phrases which involve a different version of the present invention, Applicant would now indicate that these various means (which Examiner says had not been adequately described in the specification), have now been eliminated and should no longer be a bar or impediment to the phraseology of the claims.

As a result, it will now be seen that the amended claim 1 in Applicant's Amendment dated July 7, 2003, has now been again amended so that it is twice amended. Likewise, the prior amended claim 4 has again been amended, so that claim 4 has now been twice amended from the prior amendment of July 7, 2003.

Further, the prior amended claim 8 in the Amendment of July 7, 2003 has now been amended so it is now categorized as twice amended.

In regard to the amended claim 12 from Applicant's Amendment of July 7, 2003, it is noted that this claim 12 has been newly-amended so it is categorized as twice-amended.

In Examiner's Office Action dated July 14, 2003, Examiner has rejected claims 1 and 4 under 35 USC 102(a) and (e) as being anticipated by the Rao Patent 5,930,358. Here, Applicant would traverse and take issue with the Examiner's contentions.

Examiner has rejected claims 8 and 10-13 under 35 USC 103(a) as being unpatentable over Rao, on the basis of obviousness under 35 USC 103(a). Again, Applicant would traverse this contention.

It should be noted that claims 2 and 3 have been cancelled. Likewise, claims 5, 6, and 7 have been cancelled. Likewise, claims 9, 10 and 11 have been cancelled. However, much of these phrases have been combined with the basic independent claims involved.

The Examiner has also rejected claim 5 under 35 USC 103(a) as unpatentable over Rao in view of Kohno, U.S. Patent 6,523,125. The prior claim 5 has now been consolidated with claim 4 and further, Applicant would now traverse Examiner's contention as to obviousness here.

Examiner has rejected claim 7 (now cancelled) and claims 14 and 15 (now cancelled) as obvious under 35 USC 103(a) as unpatentable over Rao in view of the American National Standards Institute (ANSI), SCSI-2 Standard, X3.131-1994.

The Examiner has rejected claim 6 (now cancelled and consolidated with claim 4) as unpatentable for obviousness under 35 USC 103(a) in view of the Rao reference and the Kohno reference in view of Lippert (U.S. Patent 6,356,906), while Examiner says that Rao "implicitly" discloses that the CPU has -- means for selecting a buffer array which most closely approximates a recognized number of bytes to be downloaded", Applicant would traverse and take issue with this.

The Examiner here cited Rao column 4, lines 24-32 and Lippert column 6, lines 53-58, column 7, lines 6-9.

Note that Rau here says -- The CPU includes a modem (not illustrated) connected to a phone line 114 which is used for downloading new microcode used to control the disk drive assembly --

Then Lippert says (column 6) -- The query 200, as already wrapped according to predetermined mark-up language, is preceded by the predetermined indicators to indicate the transport protocol that is used for wrapping, as well as to indicate anything required by that protocol, such as its version, a host location content type . . . and content length . . . .

Then Lippert, column 7, lines 6-9 says -- The Connection close specifies whether or not the server should try and maintain the network connection. . .while Content Length 243 specifies the size of the request body, in characters.

How does this teach the appropriate selection for a single or dual two-dimensional array as taught by Applicant?

The Examiner is to be congratulated for his assiduous devotion to finding references which, to some extent, can somewhat approximate the functional elements of some of Applicant's claims. However, selecting bits and pieces to re-invent Applicant's configuration is not a valid basis for rejection.

Now referring to Applicant's twice-amended claim 4, especially in regard to clauses (a) and (a1), the Rao reference at column 2 lines 8-10, does not specifically speak of devoting

software means for SCSI firmware and for SCSI servo-firmware, <u>nor</u> <u>does it indicate that control data</u> can be received from the Worldwide Web (WWW).

At this point, Examiner cites the Kohno reference at column 15 lines 30-36, where Kohno indicates a computer system 100 can be connected to the internet to make utilization of the Worldwide Web --- an updated ROM code, for example, may be downloaded from a Web server on the Internet.

Yes indeed, Kohno did mention the use of the Worldwide Web, however, from the use of hindsight, Examiner is now extrapolating the use of the Kohno statement, and inserting it into the Rao configuration, even though there was <u>no such intimation or suggestion in the</u> <u>Rao configuration</u> that such a use of the Worldwide Web might be feasible.

Now referring to Applicant's amended claim 4 clause (b2), which involves a means for selecting a buffer array size which most closely approximates said recognized number of bytes to be downloaded; --

Examiner states that this is "implicit" in the Rao reference, column 4 lines 29-32,--- but here it is to be noted that Rao says the following: The CPU includes a modem (not illustrated) connected to a phone line 114 which is used for downloading new microcode used to control the disk drive assembly 106 ---.

This Rao statement is neither "implicit" nor relevant to Applicant's claim 4, clause (b2).

This does not purport to teach any means for selecting a buffer array size which most closely approximates the recognized number of bytes to be downloaded.

Then further, Examiner cites the Lippert reference, column 7 lines 6-9, which indicates -- the connection: close specifies whether or not the server should try and maintain a network connection after the request is completed, while content-Length 243 specifies the size of the request body in characters.

Does this in any way teach the "selection of the buffer array size"?

Further, regarding claim 4, clause (b2), Examiner cites the Lippert reference, column 6 lines 53-58, which states --- the query 200, as already wrapped according to predetermined mark-up language, is preceded by predetermined indicators to indicate the transport protocol that is used for wrapping, as well as to indicate anything required by that protocol, such as its version, a host location, content type, connection type, and content length.

Here again, the Examiner through the use of hindsight is combining information from the Lippert reference into the Rao reference all the while that Rao has made no such suggestion or intimation that such capability should be put into the Rao reference.

Now, in regard to Applicant's amended claim 4, clause (c) which involves -- connection means from said local memory means over to a selected one of a plurality of disk drives for temporary storage ---

Here, Examiner cites the Rao reference, column 4 lines 41-44, which states --- the SCSI controller board 202 is connected to the host computer 100 through a SCSI cable having the appropriate connectors for attachment to the host computer and disk drive assembly.

Here, it should be noted that Applicant provides a plurality of disk drives for temporary storage which are also accessible at selected given moments for any required data or information.

In a number of the other claims, Examiner has cited the Rao reference, plus official notice that it is well-known to allocate memory, in addition to various citations from the ANSI X3 131-1994 Standards, and here, Applicant would like to indicate that the Examiner, with the benefit of hindsight and by picking and choosing various bits and pieces of techniques and technology is now re-assembling them in order to perform the overall combination that Applicant is claiming.

Applicant is claiming a combination of elements which provide an efficient and unique feature for the downloading of information to the SCSI controllers.

It should be emphasized that the combination of the defined elements, as developed in Applicant's claims provides an overall configuration of inter-cooperating elements which provide the useful functions for downloading SCSI and servo firmware to SCSI target controllers.

Yes, Rao does show a number of these features and yes, the Lippert and Kohno references do show one particular feature, as does also the ANSI X3 Standards -- but who has put these altogether in an efficiently workable system configuration, except that which was done by Applicant, as indicated by Applicant's claims?

> Who can re-engineer and redesign Rao to utilize Kohno and Lippert and the ANSI X3 Standards into a workable configuration as was done by Applicant?

A "combination" is greater than the sum of its parts, so even though certain of its parts can be indicated as having been done by someone else or taught by someone else, still, the overall <u>combination is a unique entity</u> in itself which is worthy of a claimed set of functions which totally overall acts to provide a service which is not provided by any of the individual references.

So, one must ask --- is the combination useful and efficient and a contribution to the art? Would someone be motivated to take all the various bits and pieces of the various functions and combine them in the way that Applicant did?

It could well be said that the Rao reference came fairly close in some respects so that Examiner could imply intimations and hints about various functions, but Rao did not include all the features and functions that were provided by Applicant's configuration.

In regard to the considerations of "obviousness" under 25 USC 103, it may be helpful to indicate some of the considerations provided by the Court of Appeals of the Federal Circuit. In the case of *Panduit Corp. v. Dennison Mfg. Co.*,

decided January 23, 1987, and reported at 1 USPO $2^{nd}$ at page 1593, it was stated by the Court that:

> Federal District Court erred by relying on presence, in separate prior patents, of individual elements for its conclusion that claimed cable ties were obvious. <u>Since prior art availability of such elements to all skilled workers, without suggesting anything like claimed inventions, is itself evident of non-obviousness</u>, and Court failed to follow established legal standards in finding content of prior art, <u>since it failed to treat claim, or entire prior art, or any prior art, "as a whole</u>, "but rather selected bits and pieces from prior patents that might be modified to fit its legally incorrect interpretation of each claim as consisting of one word. (underlines added).

Another example in regard to the boundaries of "obviousness" is the case of <u>*Olsonite Corp. v. Bemis Mfg. Co.*</u>, DC E Wis, 1985, where it is seen that the combining of references to portray obviousness had severe limitations as indicated by this Court:

> Claimed device is <u>nonobvious improvement on prior art</u>, even though it may not represent astounding breakthrough or new technology, since <u>nothing in prior art</u> patents, <u>either considered individually or in combination, discloses or suggests which of their elements</u> should be <u>discarded, or which should be selected, modified, and rearranged to produce claimed device</u>, and presumption of patent

validity is further reinforced by Patent Office's citation of such prior art references when issuing patent for claimed device. --- *Olsonite Corp. v. Bemis Mfg. Co.* (District Court, Eastern Wisconsin 1985) 226 USPQ 563. (underlines added)

It should also be indicated that the new claims 16 and 17 which were provided in the Amendment of July 7, 2003, <u>were not discussed or commented upon by Examiner</u>. So, it is now hoped that the protocol of steps shown in claims 16 and 17 will properly indicate an efficient and useful set of operations for downloading to a SCSI target controller.

It might be helpful, in conclusion, to just take a quick look at the Rao claim 1, which involves ----- a method for controlling a storage device having a storage medium in a non-volatile memory . . . comprising the steps of:

(a)  inputting, using a computer connected to the storage device, a parameter from a user which changes in operation of the control program stored in the storage device;

(b)  writing the parameter into the non-volatile memory of the storage device; and

(c)  controlling an operation of the storage device and the storage medium thereof, which is different from the non-volatile memory using the parameter stored in a non-volatile memory and the control program.

It is not clear in looking that Rao claim 1 how this functionality provides for the features shown in Applicant's claims 4, 8, 12, 16 and 17, for example.

It would appear that Applicant's claim terminology embraces a much more comprehensive and functional configuration, than that expressed by claim 1 of the Rao patent.

In view of the amended claims and the new claims involved here, it is respectfully requested of Examiner to give another extended look at Applicant's claims and consider them as a whole in their entirety, rather than a mere conglomeration of bits and pieces picked-out from different aspects of other technologies, and as a result, appreciate the overall functional configuration involved which provides for all the aspects for downloading firmware to the target controller, and subsequently provide a timely Notice of Allowance therefor.

Respectfully submitted,

By _Alfred W. Kozak_
Alfred W. Kozak
Reg. No. 24,265
(858) 451-4615
(949) 380-5822

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